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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,225	10/25/2001	Jeffrey G. Wiley	10016469-1	8739

7590   01/31/2005

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EXAMINER
EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	10/033,225	WILEY, JEFFREY G.
Office Action Summary	Examiner	Art Unit
	Fred I. Ehichioya	2162

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *07 January 2005*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1, 4 - 12, 14 - 27* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1, 4 - 12, 14 - 27* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *1/07/05*.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the communication filed on January 7,
2005.

2. Applicant's request for reconsideration of the finality of the rejection of the
last Office action is persuasive and, therefore, the finality of that action is
withdrawn.

However, examiner disagrees with the applicant that "It is improper to
combine references which do not suggest the properties and results of claimed
invention or that do not suggest the claimed combination as a solution to the
problem which the claimed invention solved" (page 14, paragraph 2 of
Response/Remark).

In response to applicant's above argument/remark, "A reference is
reasonably pertinent if, even though it may be in a different field from that of the
inventor's endeavor, it is one which, because of the matter with which it deals,
logically would have commended itself to an inventor's attention in considering
his problem"; *Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26
USPQ2d 1767 (Fed. Cir. 1993).* In this case, Czyszczewski, Arnon and
Stevenson references are pertinent to applicant's invention. Therefore, rejection
of last Office Action is proper.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described
as set forth in section 102 of this title, if the differences between the subject matter sought to
be patented and the prior art are such that the subject matter as a whole would have been
obvious at the time the invention was made to a person having ordinary skill in the art to which
said subject matter pertains. Patentability shall not be negatived by the manner in which the
invention was made.

Claims 1, 4 – 12, and 14 - 27 are rejected under 35 U.S.C. 103(a) as

being unpatentable over U.S Patent 6,577,907 issued to Joseph Stanley

Czyszczewski et al. (hereinafter "Czyszczewski") in view of U.S. Patent

6,321,308 issued to Dan Arnon et al (hereinafter "Arnon").

Regarding claim 1, Czyszczewski teaches a method for providing access

from a multifunction device to data operatively associated with a user-specified

remote storage device, comprising:

identifying said user-specified remote storage device based at least in part

on a path thereto specified by a user at said multifunction device (see column 3,

lines 50 – 55, column 7, lines 26 – 30 and column 10, lines 21 – 27).

establishing a link between said multifunction device and the user-

specified remote storage device having said data operatively associated

therewith (see column 2, lines 3 – 6); and

accessing said data operatively associated with said user-specified

remote storage device from said multifunction device over said link established

therebetween (see column 3, lines 50 - 60).

Arnon teaches data transfer between local and remote storage system and identifiers identifying the target device and the requesting device which also reads into applicant's claimed invention "identifying said user-specified remote storage device based at least in part on a path thereto specified by a user at said multifunction device" (see column 4, lines 60 – 66).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Arnon's teaching of "identifying said user-specified remote storage device based at least in part on a path thereto specified by a user at said multifunction device" would have allowed Czyszczewski's system to provide a queuing scheme which allows for high degree of parallelism while maintaining validity of the storage system as suggested by Arnon at column 2, lines 8 - 11.

Regarding claim 4, Czyszczewski teaches identifying said user-specified remote storage device is based at least in part on a user profile (see column 3, lines 50 – 55).

Regarding claim 5, Czyszczewski teaches converting a document to electronic format at said multifunction device (see column 2, lines 65 – 67); and combining said document in electronic format with said accessed data (see column 9, lines 3 – 7).

Regarding claim 6, Czyszczewski teaches combining said accessed data with an electronic document generated at said multifunction device (see column 11, lines 12 – 19); and

sending said combined electronic document and accessed data from said multifunction device to a network destination (see column 3, lines 1 – 7 and column 7, lines 12 – 25).

Regarding claim 7, Czyszczewski teaches accessing said data is from an address book operatively associated with said user-specified remote storage device (see column 12, lines 8 – 14).

Regarding claim 8, Czyszczewski teaches identifying a network destination for an electronic document generated at said multifunction device based on said data accessed from said address book (see column 14, lines 15 – 20).

Regarding claim 9, Czyszczewski teaches editing an entry in said address book operatively associated with said user-specified remote storage device from said multifunction device (see column 6, lines 50 – 67).

Regarding claim 10, Czyszczewski teaches configuring said multifunction device before identifying said user-specified remote storage device (see column 3, lines 56 – 60).

Regarding claims 11 and 20, Czyszczewski teaches displaying at least a portion of said data at said multifunction device (see column 10, lines 21 - 24).

Regarding claim 12, Czyszczewski teaches a method for accessing user-requested data from a configured multifunction device, comprising:

identifying a remote storage device having said user-requested data operatively associated therewith based at least in part on a path for said remote storage device specified by a user at said configured multifunction device (see column 3, lines 50 – 55, column 7, lines 26 – 30 and column 10, lines 21 – 27).

retrieving said user-requested data operatively associated with said remote storage device from said configured multifunction device (see column 10, lines 21 – 27).

Arnon teaches data transfer between local and remote storage system and identifiers identifying the target device and the requesting device which also reads into applicant's claimed invention "identifying said user-specified remote storage device based at least in part on a path thereto specified by a user at said multifunction device" (see column 4, lines 60 – 66).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Arnon's teaching of "identifying said user-specified remote storage device based at least in part on a path thereto specified by a user at said multifunction device" would have allowed Czyszczewski's system to provide a

queuing scheme which allows for high degree of parallelism while maintaining

validity of the storage system as suggested by Arnon at column 2, lines 8 - 11.

Regarding claim 14, Czyszczewski teaches identifying said remote

storage device is based at least in part on a user profile (see column 3, lines 50 –

55).

Regarding claim 15, Czyszczewski teaches converting a document to

electronic format at said configured multifunction device (see column 2, lines 65

– 67); and

combining said document in electronic format with said retrieved user-

requested data (see column 9, lines 3 – 7).

Regarding claim 16, Czyszczewski teaches combining said retrieved user-

requested data with an electronic document generated at said configured

multifunction device (see column 11, lines 12 – 19); and

sending said combined electronic document and retrieved user-requested

data from said configured multifunction device to a network destination (see

column 3, lines 1 – 7 and column 7, lines 12 – 25).

Regarding claim 17, Czyszczewski teaches retrieved said user-requested

data is from an address book operatively associated with said remote storage

device (see column 12, lines 8 – 14).

Regarding claim 18, Czyszczewski teaches identifying a network destination for an electronic document generated at said configured multifunction device based on said user-requested data retrieved from said address book (see column 14, lines 15 – 20).

Regarding claim 19, Czyszczewski teaches editing an entry in said address book operatively associated with said remote storage device from said multifunction device (see column 6, lines 50 – 67).

Regarding claim 21, Czyszczewski teaches a multifunction device comprising:

computer-readable media operatively associated with said multifunction device and having computer-readable program code thereon including program code for identifying data operatively associated with a user-specified remote storage device (see column 9, lines 38 – 49 and column 10, lines 21 - 27); and

program code for accessing said data operatively associated with said user-specified remote storage device from said multifunction device (see column 10, lines 28 – 47).

Arnon teaches data transfer between local and remote storage system and identifiers identifying the target device and the requesting device which also reads into applicant's claimed invention "identifying said user-specified remote storage device based at least in part on a path thereto specified by a user at said multifunction device" (see column 4, lines 60 – 66).

It would have been obvious to one of ordinary skill in the data processing

art at the time of the present invention to combine teaching of the cited

references because Arnon's teaching of "identifying said user-specified remote

storage device based at least in part on a path thereto specified by a user at said

multifunction device" would have allowed Czyszczewski's system to provide a

queuing scheme which allows for high degree of parallelism while maintaining

validity of the storage system as suggested by Arnon at column 2, lines 8 - 11.

Regarding claim 22, Czyszczewski teaches said data is an address book

(see column 12, lines 8 – 14).

Regarding claim 23, Czyszczewski teaches program code for retrieving an

entry from said address book, said entry identifying a network destination (see

column 12, lines 8 – 23);

program code for associating said entry from said address book with an

electronic document at said multifunction device (see column 7, lines 14 – 26);

and

program code for sending said electronic document to said network

destination identified by said entry from said address book (see column 7, lines

16 – 22).

Regarding claim 24, Czyszczewski teaches said data is a document in

electronic format (see column 2, lines 65 – 67).

Regarding claim 25, Czyszczewski teaches program code for sending a document in electronic format from said multifunction device to a network destination (see column 3, lines 1 – 7 and column 7, lines 12 – 25).

Regarding claim 26, Czyszczewski teaches program code for combining a document in electronic format with a document image at said multifunction device (see column 9, lines 3 – 7);

program code for sending said combination of said document in electronic format and said document image from said multifunction device to a network destination (see column 5, lines 30 – 40).

Regarding claim 27, Czyszczewski teaches said user-specified remote device is another multifunction device (see column 7, lines 26 – 40).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The

fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

January 27, 2005

SHAHID ALAM
PRIMARY EXAMINER